

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

3SHAPE A/S,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 18-886-LPS
)	
ALIGN TECHNOLOGY, INC.,)	CONSOLIDATED
)	
Defendant.)	

STIPULATION REGARDING REORGANIZATION OF ACTIONS

WHEREAS, defendant Align Technology, Inc. (“Align”) filed counterclaims asserting infringement of U.S. Patent Nos. 10,507,088, 10,507,089 and 9,675,430 (“the Align Patents”) on February 24, 2020 (D.I. 98);

WHEREAS, plaintiff 3Shape A/S (“3Shape”) responded to Align’s counterclaims on March 9, 2020 and asserted counter-counterclaims regarding non-infringement and invalidity of the Align Patents (D.I. 105);

WHEREAS, the parties stipulated that Align’s responses to 3Shape’s counter-counterclaims would be due April 24, 2020 (D.I. 168, So Ordered on April 21, 2020);

WHEREAS, the parties agreed that the Align Patents may be severed from this action and asserted with Align’s complaint in C.A. No. 18-1949-LPS (“the 1949 Action”) by amended complaint (D.I. 151), and that any further pleadings with regard to the Align Patents should be filed in the 1949 Action;

WHEREAS, the parties agreed that coincident with the filing of the stipulated amended complaint, Align will dismiss without prejudice its currently asserted U.S. Patent Nos. 7,357,634, 8,359,115, and 8,805,563 from the 1949 Action, and 3Shape will dismiss without prejudice its counterclaims related to those patents from the 1949 Action (*id.*);

WHEREAS, this reorganization will eliminate the need for a separate trial on the Align Patents in this case, reducing the burden on the Court and the parties, will reduce the overall number of patents asserted between the parties, and will not disrupt the schedule in this action or the 1949 Action; and

WHEREAS, the Court approved of the parties' proposal regarding the Align Patents and directed the parties to make necessary filings to effectuate the proposal (D.I. 158):

NOW, THEREFORE, the parties hereby STIPULATE and AGREE, subject to the approval of the Court, as follows:

1. Align's counterclaims with regard to the Align Patents and 3Shape's counter-counterclaims with regard to the Align Patents are hereby severed from this action;
2. Align's claims of infringement with regard to the Align Patents shall be asserted in C.A. No. 18-1949-LPS ("the 1949 Action"), as follows:
 - a. Align shall file an amended complaint in the 1949 Action by April 28, 2020 adding claims of infringement of the Align Patents against defendants in the 1949 Action¹ (3Shape A/S, 3Shape Trios A/S, and 3Shape Inc.; collectively the "3Shape Defendants");
 - b. Within 21 days of Align's filing of the amended complaint, the 3Shape Defendants shall file their response(s); and
 - c. If the 3Shape Defendants file counterclaims in response to the amended complaint, Align's response to the counterclaims shall be due 14 days after the 3Shape Defendants' filing of the counterclaims;

¹ This stipulation and order does not prejudice Align's right to seek to add additional 3Shape entities to the 1949 Action, which 3Shape may oppose.

3. By April 27, 2020, the parties to the 1949 Action shall file a stipulation dismissing without prejudice Align's claims in the 1949 Action with regard to U.S. Patent Nos. 7,357,634, 8,359,115, and 8,805,563 (the "Dismissed Patents"), and dismissing without prejudice 3Shape's related counterclaims;
4. By May 1, 2020, in the 1949 Action, Align shall serve on 3Shape Defendants a supplemental Specification of Products Accused of Infringement, the Asserted Patents, and Damages Models to account for the addition of the Align Patents and the dismissal of the Dismissed Patents; and
5. The April 24, 2020 deadline for Align to respond to 3Shape's counter-counterclaims in this action (D.I. 105) is vacated.

/s/ James H.S. Levine

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Dated: April 22, 2020

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IT IS SO ORDERED THIS ____ day of _____, 2020.

United States Magistrate Judge